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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,232	07/20/2001	Herbert Peiffer	00/121 MFE	1656

7590 02/28/2003

ProPat L.L.C.
Attention: Klaus Schweitzer
Crosby Building
2912 Crosby Road
Charlotte, NC 28211

EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,232

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claim 2 has been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because the phrase "up to 10% by weight" is inconsistent with the requirement that the outer layer contain 91-97 wt% PEN units.

Terminal Disclaimer

4. The terminal disclaimer filed on 12/16/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Serial Nos. 09/922,675 and 09/922,615 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The obviousness-type double patenting based on U.S. Serial Nos. 09/922,675 and 09/922,615 in paragraph 2 of the previous Office action has been withdrawn in view of the Terminal Disclaimer filed 12/16/2002.

7. Claims 1, 3-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/274,781 (PEIFFER ET AL) as set forth in the previous Office Action.

Application Nos. 09/274,781 (PEIFFER ET AL) claims a multilayer polyester film having a base layer, outer layer, oxygen permeability, and other features as recited in Application 09/910,232 (claims 1-2, 4, 7-15), wherein the films are further coated and/or metallized. However, the Applications do not explicitly claim films with the recited relative layer weight.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the relative thicknesses of the layers of the film claimed in 09/274,781 as indicated in claims 1, 3 depending on the specific mechanical, optical, and/or surface properties required for a given application in addition to economic considerations based

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on material costs. One of ordinary skill in the art would have incorporated additional layers such as an intermediate adhesive or bonding layer in order to obtain high adhesion between the outer and base layers as indicated in claims 5-6. One of ordinary skill in the art would have selected the orientation and heat-setting conditions of the film as indicated in claims 13-14 in order to obtain the desired mechanical and thermal properties for specific usages.

This is a provisional obviousness-type double patenting rejection.

8. Claims 1, 3-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,391,410 (PEIFFER ET AL) *or* claims 1-22 of U.S. Patent No. 6,149,995 (PEIFFER ET AL) as set forth in the previous Office Action..

Patent Nos. 6,391,410 and 6,149,995 (PEIFFER ET AL) claim multilayer polyester films having base layers, outer layers, oxygen permeability, and other features as recited in 09/910,232 (claims 1, 4-15), wherein the films are further coated and/or metallized. However, the Patents do not explicitly claim films with the recited relative layer weight.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the relative thicknesses of the layers of the film claimed in Patent Nos. 6,391,410 and 6,149,995 (PEIFFER ET AL) as indicated in claims 1, 3 depending on the specific mechanical, optical, and/or surface properties required for a given application in addition to economic considerations based on material costs. One of ordinary skill in the art would have incorporated additional layers such as an intermediate adhesive or bonding layer in order to obtain high adhesion between the outer and base layers as indicated in claims 5-6.

9. Claims 1, 3-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,054,212 (PEIFFER ET AL) as set forth in the previous Office Action.

Patent No. 6,054,212 (PEIFFER ET AL) claims multilayer polyester films having base layers, outer layers, oxygen permeability, and other features as recited in Application 09/910,232 (claims 1-2, 4, 7-15), wherein the films are further coated and/or metallized, and wherein the base layer makes up to 90 wt% of the film.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the relative thicknesses of the layers of the film claimed in Patent Nos. 6,391,410 and 6,149,995 (PEIFFER ET AL) as indicated in claims 1, 3 depending on the specific mechanical, optical, and/or surface properties required for a given application in addition to economic considerations based on material costs. One of ordinary skill in the art would have incorporated additional layers such as an intermediate adhesive or bonding layer in order to obtain high adhesion between the outer and base layers as indicated in claims 5-6. One of ordinary skill in the art would have selected the orientation and heat-setting conditions of the film as indicated in claims 13-14 in order to obtain the desired mechanical and thermal properties for specific usages.

Claim Rejections - 35 USC § 103

10. Claims 1, 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) PEIFFER ET AL (US 6,054,212); or

(b) EUROPEAN PATENT APPLICATIONS 0878298 A2 *or* 0878297 A2 (hereinafter EP '298 and EP '297, respectively); or

(c) EUROPEAN PATENT APPLICATIONS 0945256 A2 *or* 0945259 A2 *or* 0945261 A2 *or* 0945262 A2 *or* 0945263 A2 (hereinafter EP '256, EP '259, EP '261, EP '262, EP '262, respectively), as set forth in the previous Office Action.

Due to the number and duplicative nature of the references, citations to specific portions of individual reference have been omitted.

PEIFFER ET AL '212 and EP '298 and EP '297 disclose a multilayer polyester film having a base layers, outer layers, oxygen permeability, method of making, intermediate layers, relative proportions of layers, and other features as recited in claims 1, 4, 7-15, wherein the films are further coated and/or metallized. However, these references do not explicitly disclose the recited interlayer adhesion.

EP '256, EP '259, EP '261, EP '262, and EP '262 disclose a multilayer polyester film having a base layers, outer layers, oxygen permeability, method of making, intermediate layers, relative proportions of layers, and other features as recited in claims 1, 4, 7-15, wherein the films are further coated and/or metallized. However, these references do not explicitly disclose the recited interlayer adhesion.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional adhesion promoting treatments or layers to increase or maximize the interlayer adhesion in the films disclosed in the above cited references in order to prevent delamination.

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11. Claims 1, 3-15 are rejected under 35 U.S.C. 103(a) as being obvious over PEIFFER ET AL (US 6,149,995) as set forth in the previous Office Action.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

PEIFFER ET AL '995 discloses a multilayer polyester film having a base layers, outer layers, oxygen permeability, method of making, intermediate layers, and other features as recited in claims 1-2, 4, 7-15, wherein the films are further coated and/or metallized. However, PEIFFER ET AL '995 does not explicitly disclose the recited interlayer adhesion.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional adhesion promoting treatments or layers to increase or maximize the interlayer adhesion in the films disclosed in PEIFFER ET AL '995 in order to prevent delamination.

Response to Arguments

12. Applicant's arguments filed 12/16/2002 have been fully considered but they are not persuasive.

(A) Applicant argues that the prior art and double patenting references fail to specifically disclose the claimed invention containing the recited amount of ethylene-2,6-naphthalate units in the outer layer and further argues that the claimed amount of ethylene-2,6-naphthalate units in the outer layer results in superior interlayer adhesion. However, while the examples in the specification indicate some degree of improved interlayer adhesion between layers when the outer layer contains 95-97 wt% PEN and 3-5 wt% PET, the alleged showing of unexpected results and/or criticality provided by the specification is not commensurate in scope with the present claims, particularly in regard to the specific composition of the outer layer (e.g., the proportion of PEN and PET units in the outer layer) and the composition of the base layer.

The Examiner further notes that the Example 1 is confusing as to the composition of the base layer (i.e., adding up to 170 wt%), and therefore the Examiner is unable to determine the scope of the showing with respect to the composition of the base layer.

(B) Applicant argues that there is no motivation for one of ordinary skill in the art to increase or maximize interlayer adhesion in the films of the prior art. However, unless a

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laminate is specifically intended to be peelable, one of ordinary skill in the art would typically prefer the highest degree of interlayer adhesion that is practical and economically feasible. What constitutes as sufficient adhesion in a given situation depends on a variety of well known factors such as the usage conditions of the laminate (e.g., flexing, mechanical or thermal stress, etc.). Since the present claims do not preclude the use of conventional surface treatments and/or intervening adhesion promoting layers, it is the Examiner's position that interlayer adhesion in a laminate film is a design parameter which can be readily ascertained and obtained by one of ordinary skill in the art using conventional methods such as surface treatments, or if necessary, intervening tie layers. Applicant has not provided probative evidence of criticality of the recited interlayer adhesion values which is commensurate in scope with the present claims.

(C) Applicant argues that the present claims require the outer layer contain 3-9 wt% PET and 91-97 wt% PEN. However, the present claims do *not* require that the non-PEN content of the outer layer be PET units.

(D) Applicant argues that the recited proportion of the outer layer in the film is critical. However, it is the Examiner's position that one of ordinary skill in the art is capable of readily determining the optimum thickness of individual layers in a laminate film based on basic cost-benefit analysis taking into account the different costs and known properties of individual materials, as well as the specific barrier and mechanical properties required by a given application. Applicant has not provided any probative evidence of unexpected results or criticality from the recited amount of outer layer in the film.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

February 21, 2003


Vivian Chen
Primary Examiner
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